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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,251	03/09/2005	Jean Taylor	31132.339	2831
27683 7590 12/12/2007 HAYNES AND BOONE, LLP 901 Main Street Suite 3100 Dallas, TX 75202			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/527,251

Applicant(s)

TAYLOR, JEAN

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-21, 26-28 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-21, 26-28 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 11/19/2007.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 25 and 29 is withdrawn in view of the newly discovered reference(s) to Zucherman (U.S. Publication 2001/0016743) and Portney (U.S. Patent 6,152,959). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 19 is rejected under 35 U.S.C. 101 because the claim is drawn to non-statutory subject matter. In claim 19, lines 2-3, applicant positively recites part of a human, i.e. "wherein each element is connected to a treated vertebra...". Thus claim 19 include a human within their scope and are non-statutory. The examiner will interpret the claim such that the elements are capable of being connected to a treated vertebra for examination purposes.

A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. In re Wakefield, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 14-21, 26-28, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Zucherman (U.S. Publication 2001/0016743).

Regarding claims 14-21, 26-28, and 33, the examiner would like to note that the word "boss" is being broadly defined as follows, "a circumscribed rounded swelling; a protuberance." ([www.dictionary.com](http://www.dictionary.com)). Therefore, the examiner is interpreting a boss as being a protuberance. The examiner further believes that a bar is a specific type of boss or protuberance and will be interpreted as such for examination purposes. Regarding claims 14 and 28, Zucherman discloses a plurality of embodiments of a device, for example Figures 64-66, comprising an interspinous wedge, two compressive lateral elements, and two lateral transmission elements, wherein the two lateral transmission elements are bosses, such as bars. The interspinous wedge is capable of engaging with and being inserted between the spinous processes of two vertebrae, wherein the wedge includes at least one elastically deformable zone. The two compressive lateral element are disposed on either side of the wedge in a longitudinal direction and are capable of being deformed between releasing position and compressive positions. The two lateral transmission elements are disposed between the compressive lateral elements and the wedge and are capable of selectively pressing against the wedge in the transverse

direction near the elastically deformable zone. Regarding claim 15, Zucherman discloses a device wherein the zone has a limit of compressibility in the transverse direction and wherein the limit is reached at a predetermined tilted position. Regarding claim 16, Zucherman discloses a device wherein the compressive lateral elements have a limit of deformation in the transverse direction, wherein the limit is reached at a predetermined tilted position. Regarding claim 17, Zucherman discloses a device wherein the compressive lateral elements are capable of elastically deforming between the releasing and compressive positions. Regarding claim 18, Zucherman discloses a device wherein the compressive lateral elements are capable of elastically deforming generally along an axis of the spine. Regarding claim 19, Zucherman discloses a device wherein the compressive lateral elements are independent of one another, wherein each element is capable of being connected to a treated vertebra with one end and to another treated vertebra by its other end. Regarding claim 20, Zucherman discloses a device wherein the compressive lateral elements include eyelets or anchorage pieces capable of receiving pedicular anchorage screws. The examiner is interpreting the circular segment of each strap as being the anchorage pieces capable of receiving the screws. Regarding claim 21, Zucherman discloses a device wherein the compressive lateral elements are capable of being passed beneath the laminae of the overlying vertebra. Regarding claim 26, Zucherman discloses a device wherein the compressive lateral elements are capable of deforming between releasing positions, which the occupy when the vertebrae are in lordosis or when the spinal column is extended and wherein they are relatively spaced apart from the wedge in the transverse direction and

compressive positions which they occupy when the spinal column is in flexion and wherein they are relatively close to the wedge in the transverse direction. Regarding claim 27, Zucherman discloses a device wherein the two lateral transmission elements are disposed in a manner to press against the wedge in the transverse direction when the compressive lateral elements are displaced in the compressive position. Regarding claim 33, Zucherman discloses a device wherein the wedge comprises two curved recesses with each recess bounded by two lugs, wherein the lugs and the recesses are capable of broadly enveloping the spinous processes (see Figures 22 and 64).

7. Claims 14-21 and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Portney (U.S. Patent 6,152,959).

Regarding claim 14, Portney discloses a device comprising a wedge (50) capable of being inserted between the spinous processes of two vertebrae, wherein the wedge includes at least one elastically deformable zone, two compressive lateral elements (52) disposed on either side of the wedge in a longitudinal direction, wherein the compressive lateral elements are capable of being deformed between releasing positions and compressive positions, and two lateral transmission elements (58) disposed between the compressive lateral elements and the wedge capable of being selectively pressed against the wedge in the transverse direction near the elastically deformable zone, wherein the transmission elements are bosses disposed between the compressive lateral elements and the wedge. Regarding claim 15, Portney discloses a device wherein the zone has a limit of compressibility in the transverse direction, wherein the limit is reached at a predetermined tilted position. Regarding claim 16,

Portney discloses a device wherein the compressive lateral elements have a limit of deformation in the transverse direction, wherein the limit is reached at a predetermined tilted position. Regarding claim 17, Portney discloses a device wherein the compressive lateral elements are capable of being elastically deformed between the releasing and compressive positions. Regarding claim 18, Portney discloses a device wherein the compressive lateral elements are capable of elastically deforming generally along an axis of the spine. Regarding claim 19, Portney discloses a device wherein the compressive lateral elements are independent of one another, wherein each element is capable of being connected to a treated vertebra with one end and the another treated vertebra by its other end. Regarding claim 20, Portney discloses a device wherein the compressive lateral elements include eyelets or anchorage pieces (72) capable of receiving a pedicular anchorage screws. Regarding claim 21, Portney discloses a device wherein the compressive lateral elements are capable of passing beneath the laminae of an overlying vertebra. Regarding claim 26, Portney discloses a device wherein the compressive lateral elements are capable of being deformed between releasing positions which they occupy when the vertebrae are in lordosis or when the spinal column is extended and wherein they are relatively spaced apart from the wedge in the transverse direction and compressive positions which they occupy when the spinal column is in flexion, wherein they are relatively close to the wedge in the transverse direction. Regarding claim 27, Portney discloses a device wherein the two lateral transmission elements are disposed in a manner to press against the wedge in

the transverse direction when the compressive lateral elements are displaced in the compressive position.

**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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